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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,419	01/20/2004	Takahiko Iriyama	VX012307	7769
21369 7590 05/01/2008 POSZ LAW GROUP, PLC 12040 SOUTH LAKES DR. SUITE 101 RESTON, VA 20191			EXAMINER SHEEHAN, JOHN P	
			ART UNIT 1793	PAPER NUMBER
			MAIL DATE 05/01/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/759,419

Applicant(s)

IRIYAMA ET AL.

Examiner

John P. Sheehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-31 and 35-43 is/are allowed.
- 6) ☒ Claim(s) 32-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/865,476.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 18, 2008 has been entered.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/865,476, filed on May 29, 2001.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 32 to 34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3 to 7 of U.S. Patent No. 6,758,918. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims recites the same values for each of the subscripts, the same flake thickness, the same intrinsic coercive force and the same crystal structure. The two sets of claims differ only in the amount of Ce that may be substituted for Sm. The Sm proportion while not the same in the two sets of claims does overlap. Such an overlap establishes a prima facie case of obviousness in that, it would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

"The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages", *In re Peterson* 65 USPQ2d 1379 (CAFC 2003).

Also, *In re Geisler* 43 USPQ2d 1365 (Fed. Cir. 1997); *In re Woodruff*, 16 USPQ2d 1934 (CCPA 1976); *In re Malagari*, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Allowable Subject Matter

4. Claims 26 to 31 and 35 to 43 are allowed.
5. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 26 to 28, none of the references alone or combination teach or suggest a flaky isotropic SmFeN powdery magnetic material consisting of an alloy of the formula, by atomic %:



wherein $7.1 \leq x \leq 12$ and $0.5 \leq v \leq 20$, a TbCu₇ crystal structure, and flakes with a thickness of 10-40 μm,

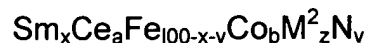
wherein

a = 0.3 at.% of the alloy composition up to 30 at.% of Sm, and

b = 2.0 at.% of the alloy composition up to 35 at.% of Fe, and

wherein the magnet alloy has an intrinsic coercive force (iH_c) of 7 kOe or higher.

Regarding claims 29 to 31, none of the references alone or combination teach or suggest a flaky isotropic SmFeN powdery magnetic material consisting of an alloy of the formula, by atomic %:



wherein $7.1 \leq x \leq 12$, $0.5 \leq v \leq 20$ and $0.1 \leq z \leq 1.0$, a TbCu₇ crystal structure, and flakes with a thickness of 10-40 μm,

wherein

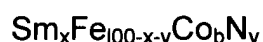
a = 0.3 at.% of the alloy composition up to 30 at.% of Sm, and

b = 2.0 at.% of the alloy composition up to 35 at.% of Fe, and

wherein the magnet alloy has an intrinsic coercive force (iH_c) of 7 kOe or higher.

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Regarding claims 35 to 37, none of the references alone or combination teach or suggest a flaky isotropic SmFeN powdery magnetic material consisting of an alloy of the formula, by atomic %:



wherein $7.1 \leq x \leq 12$ and $0.5 \leq v \leq 20$, a TbCu₇ crystal structure, and flakes with a thickness of 10-40 μm ,

wherein

$b = 2.0$ at.% of the alloy composition up to 35 at.% of Fe, and

wherein the magnet alloy has an intrinsic coercive force (iHc) of 7 kOe or higher.

Regarding claims 38 to 40, none of the references alone or combination teach or suggest a flaky isotropic SmFeN powdery magnetic material consisting of an alloy of the formula, by atomic %:



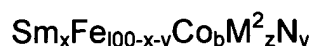
wherein $7.1 \leq x \leq 12$, $0.5 \leq v \leq 20$ and $0.1 \leq z \leq 1.0$, a TbCu₇ crystal structure, and flakes with a thickness of 10-40 μm ,

wherein

$a = 0.3$ at.% of the alloy composition up to 30 at.% of Sm, and

wherein the magnet alloy has an intrinsic coercive force (iHc) of 7 kOe or higher.

Regarding claims 41 to 43, none of the references alone or combination teach or suggest a flaky isotropic SmFeN powdery magnetic material consisting of an alloy of the formula, by atomic %:



wherein $7.1 \leq x \leq 12$, $0.5 \leq v \leq 20$ and $0.1 \leq z \leq 1.0$, a TbCu₇ crystal structure, and flakes with a thickness of 10-40 μm ,

wherein

b = 2.0 at.% of the alloy composition up to 35 at.% of Fe, and

wherein the magnet alloy has an intrinsic coercive force (iHc) of 7 kOe or higher.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (7:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Sheehan/
Primary Examiner
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JPS